

**PATENT****C. REMARKS****1. Summary**

Claims 6-9, 11-13, 18-20, and 25-38 are currently pending. Claims 27, 32, and 36 have been amended to correct a drafting error noted by the Examiner. Claims 6, 11, 18, and 38 are independent claims. No claims have been added or cancelled in the response.

**2. Drawings**

Applicants note with appreciation the acceptance of Applicants' formal drawings by the Examiner in the Second Non-Final Office Action.

**3. Claim Rejections - 35 U.S.C. § 112**

Claims 27-29, 32-33, and 36-37 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. In particular, the Examiner asserted that the claimed limitation "sending the travel plan message from the travel agent computer system to the email system prior to the email system's reception of the travel plan message" was confusing. Applicants have amended the limitation, eliminating the phrase "prior to the email system's reception of the travel plan message." In light of Applicants' amendment, the rejection under § 112 has been overcome and Applicants respectfully request the withdrawal of the rejection by the Examiner.

**4. Claim Rejections - 35 U.S.C. § 103**

Claims 6-8, 11-13, 18-20, 25-29, 31-33 and 35-38 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,453,687 to Sharood et al. (hereinafter "Sharood"), in view of U.S. Patent No. 6,650,635 to Weinstein et al. (hereinafter "Weinstein"), in further view of U.S. Patent No. 6,496,568 to Nelson

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(hereinafter Nelson). Applicants respectfully traverse the rejections.

Regarding the three references used by the Examiner to support the rejection, Sharood teaches a "refrigeration monitor unit" that includes circuitry and sensors to monitor a refrigeration appliance that, among other things, helps determine when food spoilage will occur (col. 1, lines 51-65). Weinstein is a network telephone communication patent that is directed towards "voice communication over a network" that includes a telephone, a data network, a device coupled to the data network, and a routine that controls communication of voice data between the telephone and the data network (col. 1, lines 45-57). Finally, Nelson is a patent teaching a method for automated notification to a customer of a real-time notification system (abstract). The three references cited in the Office Action in support of the rejection of Applicants' claims have little to do with one another. The Examiner provided absolutely no showing of how one of ordinary skill in the art would be motivated to combine a refrigeration monitoring reference, a voice telephone reference, and an automated notification reference with one another.

There is simply no motivation, found in the prior art, to combine the references of Sharood, Weinstein, and Nelson. Instead, it is obvious that the Examiner improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the Office Action used impermissible hindsight in combining Sharood, Weinstein, and Nelson in order to support a rejection of Applicants' claims.

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MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid ( 35 U.S.C. 282) and constitute a property right ( 35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the

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rationale for decisions made during prosecution of the application.

Applicants assert that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Office Action fails to explain how combining the refrigeration monitoring system of Sharood with the voice telephone communication of Weinstein with the automated notification system of Nelson would result in a workable solution without relying on Applicants' disclosure. Thus, Applicants contend that the Office Action used impermissible hindsight in rejecting Applicants' claims.

A well established rule of patent law is that all claim limitations must be taught or suggested. MPEP 2143.03 states:

**2143.03 - All Claim Limitations Must Be Taught or Suggested**

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 6, which is indicative of Applicants' independent claims, includes the limitations of:

registering a home automation system with an email computer system, the registration including a network address corresponding to the home automation system;  
storing the home automation system's network address on a storage device accessible from the email computer

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system, the storing performed in response to the registering;  
scheduling the travel plans using a travel agent computer system;  
receiving the scheduled travel plans at the email computer system;  
retrieving the home automation system's network address from the storage location in response to the received travel plan message; and  
sending a home automation message from the email computer system to the home automation system network address, the home automation message resulting in an automated response performed by the home automation system.

Applicants noted in the First Response (filed Nov. 14, 2003), that none of the references cited by the Examiner taught or suggested the step of "registering a home automation system with an email computer system..." In the Second Non-Final Office Action, the Examiner admits that "Sharood et al. do not specifically teach registering said home automation system with an email computer system and scheduling travel plans using a travel agent computer system." Instead, the Office Action asserts that Weinstein, while not teaching such registering, "implies [a] prior registering step." Applicants point out that the Second Office Action never teaches such registering, and neither the section of Weinstein cited by the Examiner nor the remaining sections of Weinstein teach or suggest "registering a home automation system with an email computer system..." The section of Weinstein relied upon in the Second Office Action are three claims (part of independent claim 5, claim 6, and claim

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7). The section of claim 5 of Weinstein includes the following limitations:

5. A method comprising:

...

connecting the phone to a computer;

receiving a voice command from the phone;

interpreting said voice command; and

performing an action in response to the voice command.

Claim 6 is as follows:

6. The method of claim 5 wherein said action includes completing a phone call.

Claim 7 of Weinstein is as follows:

7. The method of claim 5 wherein said action includes turning on or off lights controllable by said computer.

Applicants are dismayed and completely befuddled as to how the Examiner posits that the above three claims of Weinstein teach Applicants step of "registering a home automation system with an email computer system..." The claim language cited by the Examiner never even mentions an email computer system, nor does the claim language teach or suggest registering a home automation system with an email system. Weinstein teaches and claims "receiving voice commands" to perform actions. It appears that the Examiner is attempting to re-write Applicants' claims in order to fall within the scope of art that the Examiner was able to locate, regardless of whether the

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references lacked teaching or suggesting anything being claimed by Applicants.

As is described in detail above, the Examiner did not examine Applicants' claim limitations in forming the rejection under 35 U.S.C. § 103. Instead, the Examiner rewrote Applicants' claims to more closely match the teachings of a particular reference. Applicants respectfully request a re-examination of Applicants' claimed limitations, with consideration to Applicants' actual claimed limitations.

In addition, Applicants point out that the Second Non-Final Office Action contains little analysis explaining the Examiner's rejection. Instead, Applicants are presented with snippets from various pieces of prior art that are asserted against Applicants' claims regardless of whether the art being cited by the Examiner actually performs the steps claimed by the Applicants and regardless of the fact that there is no motivation whatsoever to combine the refrigeration teachings of Sharood, the voice communications of Weinstein, with the automated notification teachings of Nelson. The Examiner simply concludes, in conclusory fashion, that "it would have been obvious..." to perform Applicants' claimed invention using the disparate and unrelated teachings of Sharood, Nelson, and Weinstein "because it is well know [sic] to use travel agent services to plan a vacation." Applicants respectfully point out that none of the prior art asserted by the Examiner teaches or suggests automated "travel agent services," so it is an incredible leap of logic that one of ordinary skill in the art would know to combine the cited references without the benefit of Applicants specification and claims.

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Finally, Applicants point out that combining the references cited by the Examiner would either disable or render the teachings of the prior art references inoperative or impaired. Combining the teachings of Sharood with Weinstein would add voice communication ability to a refrigeration monitoring apparatus. Applicants can scarcely ponder what such resulting apparatus would resemble or why any sane individual would attempt such combination. The Office Action never bothers to set forth any plausible reason on why such a combination would be sought, other than to render Applicants' claimed invention "obvious" after using Applicants' claim limitations as guideposts to locate prior art and impermissibly re-write Applicants' claims as performing voice recognition aspects taught by Weinstein.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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